

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jay P. POWERS et al.

Title: **TRIAZOLE COMPOUNDS AND USES RELATED THERETO**

Appl. No.: 10/587,846

International 10/27/2004

Filing Date:

371(c) Date: 9/5/2006

Examiner: Golam M. Shameem

Art Unit: 1626

Confirmation 9842

Number:

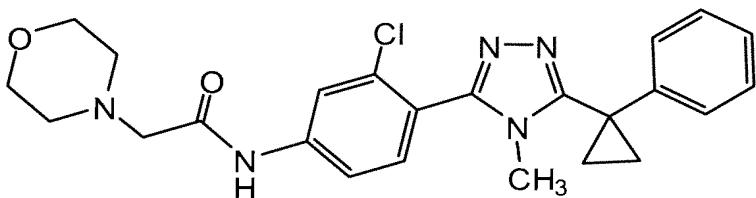
RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This submission is responsive to the restriction requirement set forth in the Office Action mailed on March 12, 2009. Because the due date, April 12, 2009, occurred on a Sunday, this response is timely filed with no need for an extension of time.

With traverse, Applicants provisionally elect **Group I (claims 1 -18)** for examination. In response to the species election requirement, Applicants elect as a species the compound shown below as reflective of the elected group of claims. The elected compound is disclosed in the specification on page 17 as example 1-31:



Claims 1-6, 8, 10, and 14 read on the elected species.

In the Office Action, the PTO required restriction into four groups: Group I, consisting of Claims 1-18, drawn to compounds (1-17) and pharmaceutical compositions comprising those compounds (18); Group II, consisting of Claim 19, drawn to an HSD1 inhibitor comprising a compound of any of Claim 1-17; Group III, consisting of Claims 20-22, drawn to a method of using a compound of any of claims 1-17; and Group IV, consisting of Claims 23-40, drawn to methods of treatment of certain specified diseases comprising administration of a compound of any of claims 1-17.

Applicants respectfully traverse the PTO's requirement because it contravenes PCT Rule 13 that governs unity of invention generally. In particular, the requirement contravenes the very sections which the PTO has cited – namely, PCT Rules 13.1, 13.2 and MPEP Annex B, Parts 1(b) and (e).

Specifically, under PCT Rule 13.2, the requirement for Unity of Invention is fulfilled when claims share one or more of the same “special technical features.” Further, Annex B, part 1(b), which is quoted by the PTO, provides that the phrase “special technical features” means those technical features which define a contribution over the prior art. Applicants assert that the novel triazole compounds of this invention, which are the present invention’s contribution over the prior art, and which are the heart of all 40 claims, constitute that special technical feature that is shared by all four Groups which the PTO has alleged to be distinct inventions.

Moreover, Annex B, Part 1(e), which also is quoted by the PTO, provides that the method for determining unity of invention is to be construed as permitting the inclusion of “in

addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product." Noting that all 40 claims are directed either to products or to methods of using those products, Applicants submit that, in particular, Groups I (compounds and pharmaceutical compositions comprising them) and IV (methods of use) fit squarely into this illustration. Therefore, Applicants respectfully assert that, *at the very least*, Groups I and IV should be examined together. Accordingly, Applicants request withdrawal of the lack-of-unity objection at least as regards Groups I and IV.

Applicants note their right to rejoinder of non-elected claims either that are written in dependent form to an allowed generic claim or that otherwise include all the limitations of an allowed generic claim. Applicants also reserve the right to file a divisional application covering non-elected subject matter.

Applicants now await an early and favorable action on the merits. The Examiner is invited to contact Applicants' undersigned attorney by telephone at the number below if he wishes to discuss any issue in connection with this application.

Respectfully submitted,

Date April 13, 2009

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extension fees to Deposit Account No. 19-0741.